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10/728,345	12/04/2003	Shih-Fu Chang	A31067-PCT-USA	8618
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EXAMINER				
RAO, ANAND SHASHIKANT				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DL.NYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/728,345

Applicant(s)

CHANG ET AL.

Examiner

Andy S. Rao

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/30/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 is/are pending in the application.
- 4a) Of the above claim(s) 19-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 8/20/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the second embodiment (figure 8a) as in the reply filed on 9/30/08 is acknowledged. The traversal is on the ground(s) that all the embodiments share special technical features and in particular with regards to species IV and V as read on by claims 20 and 21 should specifically not be subjected to the requirement (Amendment of 9/30/08: page 9, lines 4-18). This is not found persuasive because while there is some commonality amongst the elements, the species themselves are independent or distinct because the claims directed thereto recite the mutually exclusive characteristics of such species, and with regards to species IV and V, for instance, the Examiner notes that it is entirely possible to generate a reduced speed sequence of frames video information, without resorting to using a frozen frame. In addition, these species are not obvious variants of each other based on the current record. *The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.*

The requirement is still deemed proper and is therefore made FINAL.

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16- 18 are rejected under 35 U.S.C. 101 as not falling within one of four statutory categories of inventions. Supreme Court precedent and recent Federal Circuit decisions indicate a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example there is not apparatus mentioned either in the preamble nor in the subsequent limitations for executing the method, nor is the create of a first and second frame of the dissolve regions considered transforming the signal, as the processing appears to contained in the frequency domain, *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Arman et al., (hereinafter referred to as “Arman”).

Arman discloses a method for dissolving an incoming scene of video information which comprises a sequence of fields or frame of compressed video information and an outgoing scene of video information which comprises a sequence of fields or frame of compressed video information (Arman: column 4, lines 20-37), comprising the steps of: applying DCT domain motion inverse compensation to obtain DCT coefficients for all blocks of video information which make up a last frame of said outgoing video scene (Arman: column 5, lines 35-57); applying DCT domain inverse motion compensation to obtain the DCT coefficients for all blocks of video information which make up the first frame of said incoming video scene (Arman: column 6, lines 30-45); and creating a first frame in a dissolve region from said DCT coefficients of said last outgoing frame and said first incoming frame (Arman: column 6, lines 55-67), as in claim 16.

Regarding claim 17, Arman further comprising the step of choosing an initial value for a weighing function prior to step (Arman: column 12, lines 1-32), as in the claim.

Regarding claim 18, Arman further comprising the steps of incrementing said weighting function value (Arman: column 13, lines 1-10); and creating a second frame in said dissolve region from said DCT coefficients of said last outgoing frame and said first incoming frame using said incremented weighing function value (Arman: column 13, lines 10-50), as in the claim.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jun discloses a method for detecting dissolve/fad in MPEG-compressed video environments. Yim discloses a field/frame conversion of DCT domain mixed field/frame mode macroblocks. Koylczynski discloses a process and apparatus for performing wipes on compressed MPEG video bitstreams.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (571)-272-7337. The examiner can normally be reached on Monday-Friday 8 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571)-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andy S. Rao
Primary Examiner
Art Unit 2621

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/Andy S. Rao/
Primary Examiner, Art Unit 2621
December 5, 2008